

R E M A R K S

After careful consideration of the outstanding Office Action, this application has been amended accordingly, and favorable reconsideration on the merits thereof is at this time respectfully requested.

At page 2, the first paragraph thereof, the Examiner objected to claims 10/9 and 11/10/9 as being improper multiple dependent claims because of alleged dependency "from another multidependent claim." On March 25, 2004 a PRELIMINARY AMENDMENT was contemporaneously filed with the filing of this application and the multiple dependency of claims 9 and 10 was changed such that the claims respectively depend from claims 5 and 1. The March 25, 2004 Amendment has been entered into the record, as reflected in the attached printout of the "Transaction History" of the PTO PAIR database. Therefore, the rejection due to multiple dependency is moot.

The major rejection of record appears at page 2, paragraph 3 at which the Examiner has rejected claims 1 through 3 and 12 "under 35 U.S.C. § 102(b) as being anticipated by Bernhardt et al. (U.S. 4,852,217)." The Examiner was also kind enough to reproduce Figure 1 of the Bernhardt et al. patent at the top of page 3 of the Office Action and added notations identifying rollers 10, 12 as "drawing-in means," roller 14 as "licker-in" means, rollers 16, 18 as "Transfer means," roller 20 as "main cylinder" and rollers 22, 24 as "doffing means." In actual fact, the Bernhardt et al. patent describes a "draw-in roller 10," a "licker-in roller 12," a "first worker roller 14," a "second worker roller 16," a "third worker roller 18," a "fourth worker roller 20," fifth, sixth and seventh worker rollers 22, 24 and 25, respectively, and the latter roller being followed by "two doffing cylinders 26, 27." (See column 3, lines 3 through 22.)

Obviously, the Examiner is aware of the Bernhardt et al. description at column 3, lines 3 through 22, otherwise he would not have identified the various Bernhardt et al. rollers with terminology **inapplicable** thereto. As one example, the Examiner identifies "drawing-in means" by two double-headed arrows directed to the rollers 10, 12 which, as noted earlier, are described as "the draw-in roller 10" and the "licker-in roller 12" (column 3, lines 1 through 3). Clearly, the Examiner is misdescribing the licker-in roller 12 of Bernhardt et al. as part of the "drawing-in means" when it is not and is similarly obviously intentionally misdescribing the "first worker roller 14" of Bernhardt et al. as the "licker-in" means or licker-in roller. The same is true of the misdescription of the succeeding "worker" rollers 16, 18, 20, 22 and 24 as "transfer means," main cylinder and "doffing means."

Under 35 U.S.C. § 102, applicant is entitled to a patent unless "the invention" was known or used by others, patented or described here or abroad, was in public use or on sale in the United States, etc. Section 103(a) emphasizes the difference between "the invention" of Section 102 (identical) as disposed to an invention which includes "differences between the subject matter sought to be patented and the prior art." However, whether applying Section 102 or 103, of initial concern is "the subject matter sought to be patented," namely the claims at issue. The latter may seem apparent and straightforward, but for emphasizes the undersigned makes reference to Stoller v. Ford Motor Co., 18 USPQ 2d 1545, 1546 in which the CAFC stated:

A prior art reference anticipates a claim, and thus invalidates it under 35 U.S.C. § 102, if that reference **discloses each and every element of the claim.** (*Emphasis added.*)

The “each and every element” of the claim means precisely that, namely, the each and every element claimed in must be “disclosed” in the prior art reference, not a reinterpretation or misinterpretation thereof. In Panduit Corp. v. Dennison Manufacturing Co., 1 USPQ2d 1593, 1597, the CAFC re-emphasized the Supreme Court’s decision in Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and emphasized reaching proper legal conclusions “against” the “background” of answers to factual inquiries with respect to a Section 103 determination which, of course, is likewise applicable to a determination of Section 102. At page 1602 the Panduit court stated:

No effective, uniform, reliable patent system could long survive if the law permitted a decisional approach to §103 determinations like that here employed by the district court and suggested in Dennison’s Petition for Certiorari: (1) interpreting claims by redrafting them to one word; (2) implying that that word describes the ‘differences’; (3) picking from a prior patent an item describable by that word (in effect finding *no* differences); (4) focusing on isolated minutia in a prior art patent while disregarding its scope

With the latter in mind and proceeding under the dictates of the Supreme Court and the CAFC, contrary to the Examiner’s conclusion, Bernhardt et al. does **not** disclose “a drawing-in means (10, 12),” because reference numeral 12 “discloses” a licker-in roller. Likewise, Bernhardt et al. does **not** disclose “a licker-in 14” because the latter is disclosed to be a working roller. Bernhardt et al. does **not** “disclose” a “main cylinder 20” because the latter is disclosed

in Bernhardt et al. as a fourth working roller, and the alleged “at least one fiber doffer means (22, 24)” of Bernhardt et al. are two working rollers. How can the Examiner pretend to properly interpret the Bernhardt et al. patent when working rollers 22 and 24 specifically disclosed and described therein are misinterpreted as a main cylinder and at least one fiber doffer means, respectively? Misinterpreting and misapplying the prior art patent to Bernhardt et al. under Section 102(b) is patently apparent from the Examiner’s descriptive portion of the rejection and the illustration thereof. Based upon the foregoing, the Bernhardt et al. patent fails to anticipate claims 1 through 3 and 12 under 35 U.S.C. § 102(b), and the withdrawal thereof is respectfully requested.

It is also noted that claim 1 as originally presented and as amended is not as broad as the Examiner perceives. For example, the claim recites “fiber doffer **means** (18) engaged with the main cylinder (16) **for doffing** a fibrous web.” The latter-quoted limitation is drafted in strict compliance with 35 U.S.C. § 112, the last paragraph thereof. In order to anticipate this limitation, the Examiner must find in the prior art the patent to Bernhardt et al. corresponding structure or equivalents thereof. Doffing cannot be performed and is not performed by working rollers 22, 24, as is evident from column 3, lines 30 through 55 of the Bernhardt et al. patent. The worker rollers 16, 18, 20, 22, 24 and 25 transfer and/or store fibrous material but doffing does not occur until downstream beyond the worker roller 25, as is clearly evident from column 3, lines 46 through 55 of the Bernhardt et al. patent.

Most importantly and as is characterized in claim 1, the recited plurality of transferred rollers include “a random roller (10, 10a, 10b, 10c) rotating in the same direction as the main cylinder (16) and the licker-in roller (6).” The actual and factual licker-in roller disclosed by Bernhardt et al. is the licker-in

roller 12 which rotates counterclockwise followed by a clockwise rotating worker roller 14 and absent any main cylinder, irrespective of the Examiner's designation of the working roller 20 as such. Once the Bernhardt et al. patent is properly interpreted, as would be done by a person skilled in the art, the only "fiber doffing means... for doffing a fibrous web" are the doffing cylinders 26, 27. Claim 1 requires the fiber doffer means (18) to be "engaged with the main cylinder (16)." In Bernhardt et al. the doffing cylinders 26, 27 are engaged with the seventh worker cylinder 25 not with the third worker roller 20 which the Examiner mischaracterizes as a main cylinder.

With due respect, the rejection of claims 1 through 3 under 35 U.S.C. § 102 (b) as being anticipated by the patent to Bernhardt et al. is totally untenable and the withdrawal thereof would be most appreciated.

The same comments made with respect to claim 1 are equally applicable to method claim 12 and are hereat incorporated by reference in order not to unduly lengthen this record. Accordingly, the formal allowance of claim 1 is also respectfully requested.

Turning to the rejection of the dependent claims, since the Examiner is incorrect in stating that "Bernhardt et al. discloses the invention substantially as claimed," the secondarily applied patent to Rubenach (U.S. 6,553,630) is of no consequence. Accordingly, upon the formal allowance of independent claim 1, the formal allowance of the remaining claims of record, including those indicated as being allowable at page 4, paragraph 6 of the outstanding Office Action, would be most appreciated.

The Examiner's attention is directed to the fact that the corresponding European patent has been granted under EP 1 464 738 B1 (copy attached). Patent claims 1 through 12 correspond to claims 1 through 12 originally of

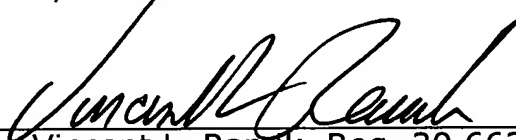
record herein. The European Patent Office is quite stringent with respect to the quality of its searching and the scope of claims allowed thereby. Considering the fact that the primary patent to Bernhardt et al. applied by the Examiner herein is incapable of anticipating or rendering obvious the subject matter of the presently amended claims, like patenting thereof as was done by the European Patent Office, is herewith requested.

In view of the foregoing the formal allowance of this application at an early date would be most appreciated.

Very respectfully,

DILLER, RAMIK & WIGHT

By:



Vincent L. Ramik, Reg. 20,663.

Merrion Square Suite 101
7345 McWhorter Place
Annandale, Virginia 22003

(703) 642-5705 - telephone
(703) 642-2117 - fax

Attachment: Print-out
 EP 1 464 738 B1